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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,303	05/24/1999	BRUCE A. DONOHO	DONO-7	8945
34284	7590	04/26/2005	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			PALO, FRANCIS T	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/317,303

Applicant(s)

DONOHU, BRUCE A.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

HC

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to canceled claims 1, 3, 5, 6 and 8 have been considered but are moot in view of the newly presented claims 10-32 in this revived and continued examination application.

In consideration of the Applicant's comments the Examiner wishes to point out that the Applicant's US 5,253,444 Patent teaches the same objective of the instant application; specifically, providing a bird repellant apparatus made entirely of low cost plastic made by injection molding, as does other prior art such as GB 2344269 to Richardson, having earlier filing dates.

Finally, in consideration of the new claims, the Examiner presents new art of rejection for the Applicant's consideration, and it is the Examiner's position that the instant invention is obvious over GB 2344269, as modified.

### ***Claim Objections***

Claims 10, 11, 13, 14, 18, 24 and 32 are objected to because of the following informalities, correction is required.

Art Unit: 3644

Regarding claim-10:

The Examiner suggests rewriting the claim as suggested below to overcome any ambiguity over whether the rail and prongs are integrally molded as a unitary or monolithic apparatus, and to address the indefiniteness of the limitation to "normal" as currently cited in the instant independent claim. These considerations by the Examiner are proposed with respect to the 32-lines of detailed description found in the specification wherein, "the prongs 14 are provided at various angles relative to the underlying surface" is recited, and "normal" is not recited.

Proposed claim:

*A bird deterrent for mounting on a surface, comprising; an elongated rail and a plurality of laterally extending prongs which is injection molded as a single continuous piece, said laterally extending prongs alternating at various angles relative to the underlying surface.*

If the Applicant intends a broader and indefinite recitation as presented, an indefiniteness rejection and resulting broader application of the prior art should be anticipated in the next office action. The instant claim is interpreted as proposed.

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Regarding claim-11:

In line-3, "higher angles" should be changed to --greater angles-- for consistency with the parent claim terminology.

Regarding claims 13, 14 and 18:

The instances of "extending" should be changed to --extend--.

In claims 13 and 14, the instances of "normal" should be changed to --the underlying surfaces of the rail--, as discussed above regarding claim-10.

Regarding claim-24:

In the claim, "of the rail has a longitudinally running trough" should be changed to --and a longitudinal trough on said surface--.

Regarding claim-32:

In the claim, "flanges" should be changed to --prongs--.

There is no antecedent basis for flanges in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 10-12, 14-18, 20, 22-27 and 30-33** are rejected under 35 U.S.C. 102(a) as being anticipated by Richardson (GB 2344269) filed 3/12/1998.

Regarding **independent claims 10 and 31**:

Richardson teaches a bird repellant device in the Abstract, having;

a base element (rail as cited) of plastic material molded (read as encompassing “injection molding” as cited) integrally with a plurality of plastics material prongs extending at at least four different angles to the base element, and the plurality of prongs may extend from the base element as a sequence of laterally staggered first and second pairs of mutually diverging prongs located in planes that are spaced apart in a direction transverse to the planes.

With respect to independent **claim-31**; Richardson depicts in Figure-1 superiorly extending prongs (13) alternating with pairs of laterally extending prongs (11,12), as cited.

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Regarding **claim-11**:

The alternating prongs as cited are readily apparent from the figures of Richardson.

Regarding **claim-12**:

The repetitively spaced alternating prongs as cited are readily apparent from the figures of Richardson.

Regarding **claim-15**:

Richardson discloses on page-4 in the paragraph beginning at line-6, paired prongs (11,12) angled at on the order of 82 and 120-degrees respectively to the horizontal, and paired prongs (13,14) angled at on the order of 60 and 108-degrees. The difference between the angles of adjacent laterally extending prongs therefore are on the order of 38-degrees for the (11,12) pair and 48-degrees for the (13,14) pair. The angle difference of the (13,14) pair therefore reads on the "about 40 degrees" limitation as cited in the instant claim.

Regarding **claim-14**:

The discussion above regarding claim-15 is relied upon.

Specifically, Richardson discloses the angle of prong (13) to be on the order of 60-degrees, which is read as about 70-degrees as cited. The Applicant should note no criticality is found in the disclosure to any prong angle claimed.

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Regarding claims **16-18**:

Richardson depicts in Figure-1 structure readable on flanges as cited which extend horizontally from the rail (base), continuous with the one of the plurality of prongs and alternating (see mid-section) as cited.

Regarding **claims 20 and 22**:

Round prongs terminating in a sharp tip as cited are readily apparent from the figures of Richardson.

Regarding **claim-23**:

A flat bottom surface rail (base) as cited, is readily apparent from the figures of Richardson.

Regarding **claim-24**:

Richardson teaches a series of longitudinal running countersunk cruciform apertures in the base for adhesive to egress from to form a keying bond, which is readable on a conventional definition of trough (conduit, drain or channel).

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Regarding **claim-25**:

Richardson depicts a ridge (18) along the upper surface, as cited.

Regarding **claim-26**:

Richardson depicts a plurality of prongs (13) extending superiorly from the rail (base) as cited.

Regarding **claim-27**:

Richardson depicts the superiorly extending prongs (13) alternating with pairs (11,12) as cited.

Regarding **claim-30**:

Richardson teaches lines of weakness provides by transverse grooves of preferably V-shaped cross section to allow a desired length to be snapped off, said notches are capable of cutting.

Regarding **claim-32**:

Richardson depicts structure that reads on support for the superiorly extending prongs and side surfaces from which extend supports for the laterally extending prongs as cited.

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Regarding **claim-33**:

The discussion above regarding claim-31 is relied upon.

The discussions above regarding claims 24 and 30 encompass the limitations of the instant claim as cited.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (GB 2344269) filed 3/12/1998.

Regarding claims **13 and 28**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches in the Abstract, prongs extending at at least four different angles from the base element, and discloses angles of 60, 82, 108 and 120-degrees.

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In the absence of any stated problems solved by or any stated advantage obtained by having a certain feature as claimed in the instant invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include prongs extending laterally and superiorly as cited, as Richardson in addition to the four disclosed prong angles also teaches at least four different angles.

**Claims 19, 21, 29 and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claim-10 above, and further in view of Shaw (US 3,282,000) 1963.

Regarding claims **19, 21 and 34**:

The discussion above regarding claim-10 is relied upon.

Richardson is silent as to cross-shaped prong cross-section. Richardson does teach a sharp tip prong design.

Shaw teaches in Figure-12 a prong readable as cross-shaped in cross section as cited.

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In the absence of any stated problems solved by or any stated advantage obtained by having a certain feature as claimed in the instant invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include prongs as cited in the instant claims, as further such modification is merely an alternate equivalent prong design performing the same intended function of deterring birds from perching on an underlying surface.

Regarding **claim-29**:

The discussion above regarding claim-10 is relied upon.

Richardson is silent as to a ridge running along an upper surface of the rail (base) wherein superiorly extending prongs extend, Richardson does teach superiorly extending prongs extending from the base.

Shaw teaches a ridge extending along the upper surface of the rail (base) having superiorly extending prongs as cited.

In the absence of any stated problems solved by or any stated advantage obtained by having a certain feature as claimed in the instant invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include a ridged rail as cited and as taught by Shaw, as further such modification is merely an alternate equivalent rail (base) design for extending prongs from.

### ***Conclusion***

As evidenced by the numerous claim objections, this revived continuation application is still in condition for considerable cleanup, the Examiner also observes that there are 32-lines of detailed description in the specification covering 24 claims, and five objectives outlined. The Applicant and representative are cautioned that the specification lacks criticality for a number of the dependent claims and no new matter will be permitted as a means to lend criticality to such claims in the response to this office action.

The Applicant is further advised to consider options to ensure that criticality is afforded the dependent claims that are considered novel to further the patentability effort, and that this RCE application may not be the venue for that end.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Girardl teaches a deterrent formed of plastic wherein the prongs and base are coformed as a single piece, cutting notches are also taught.

L'Hermite teaches laterally extending prongs.

Lefrancois teaches a plastic base, zones of weakness and a longitudinal notch on the underside of the base.

Karaa teaches adhesive mounting and transverse cutting grooves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Francis T. Palo*

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Examiner  
Art Unit 3644